

U.S. Application No.: 09/830,732
AMENDMENT D

Attorney Docket: 2368.119

REMARKS

Review and reconsideration of the Office Action dated August 24, 2004, is respectfully requested in view of the above amendments and the following remarks.

Applicant would like to thank the Examiner for the indication that Claims 13-14 are allowable. Applicant believes that the remaining claims are also allowable.

Claims 10 and 15 have been cancelled. Claim 11-12 and 16-17 have been amended to depend on novel Claim 19. Claim 20 has been amended to refer to a soft concealment covering. Support for the claim amendment can be found on page 8, paragraph [00044] of the specification as originally filed, which indicated **"enveloping possibilities for camouflage with leather, cloth"**. **Cloth is a soft material.**

No new matter has been added to the claims.

Applicant believes that Claim 19 and 22 are novel for the following reasons:

Neither of the references taken alone or in combination shows a first and second locking system being independent from each other.

In addition, all the references fail to teach:

1) a housing having boreholes to enclose a closable case; 2) a locking system to lock the case within the housing; 3) a

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closable case including **locking bolts** to engage with the bolts of the housing to lock the closed case inside the housing; and 4) **two independent security systems**.

Office Action

Turning now to the Office Action in greater detail, our comments thereon are set forth below to facilitate your review.

Paragraphs 3-5 (Obviousness)

The Examiner rejects Claims 10, 11, and 15-17 under 35 U.S.C 103(a) as being obvious over West (U.S. Patent 4,452,390) in view of GB 2039599 (GB '599).

In addition, the Examiner cited Brush, Jr. et al. (U.S. Patent 4,688,493) with respect to Claims 16 and 17, as an evidentiary reference.

The position of the Examiner can be found on pages 2-3 of the Office Action.

Applicant respectfully traverses. The rejection is moot in view of the fact that independent Claims 10 and 15 have been cancelled. Claim 11-12 and 16-17 have been amended to depend on novel Claim 19. Arguments regarding the novelty of Claim 19 can be found below.

Accordingly, withdrawal of the rejection is respectfully

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requested.

Paragraphs 6-8 (Obviousness)

The Examiner rejects Claim 12 under 35 U.S.C 103(a) as being obvious over West (U.S. Patent 4,452,390) in view of GB 2039599 (GB '599) as applied to Claim 10 about, and further in view of, Johnson et al. (U.S. Patent 2,819,692).

The Examiner rejects Claim 18 under 35 U.S.C 103(a) as being obvious over West (U.S. Patent 4,452,390) in view of GB 2039599 (GB '599) as applied to Claim 15 about, and further in view of, Cantley (U.S. Patent 3,970,010).

The position of the Examiner can be found on pages 2-4 of the Office Action.

Applicant respectfully traverses. The rejection is moot in view of the fact that claims 12 and 18 have been amended to depend on novel Claim 19. Arguments regarding the novelty of Claim 19 can be found below.

Accordingly, withdrawal of the rejection is respectfully requested.

Paragraphs 9-12 (Obviousness)

The Examiner rejects Claims 19-21 under 35 U.S.C 103(a) as being obvious over Sakai (U.S. Patent 5,170,907) in view of McConnell et al. (U.S. Patent 4,786,472).

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The position of the Examiner can be found on pages 4-5 of the Office Action.

Applicant respectfully traverses.

Regarding the Saki reference

Compared with Claim 19, the reference fails to teach: 1) a case having a handle; 2) a first security locking system to independently lock the case; 3) a second locking system to lock the case within the housing; 4) a housing **having boreholes**; and 5) a closable case including **locking bolts** to engage with the bolts of the housing to lock the closed case inside the housing.

Applicant notes that the reference teaches a personal security case including a closable case, a housing, a security system for the case. The case comprises a security system that locks **simultaneously** the case and the case with the housing.

Applicant notes that the Examiner is of the opinion that element 10a and 10b of the reference correspond respectively to the **independent security locking system** of the case and at the locking system associated with the housing. Applicant notes that element 10 shows three pawl portions 10a, 10b, and 10c which can be brought into different positions by simply rotating the pawl member 10. The different positions allow for different locking functions as follows:

- a) a case 3 locked, case 3 secured to holder 2; or

- b) a case 3 locked, case 3 being remove from holder (take away position); or
- c) a case 3 secured to holder 2, lid 14 unlocked; or
- d) a case removed from holder 2, lid 14 unlocked.

Therefore, there is only one single locking system which is responsible for locking case 3 as well as securing case 3 to holder 2. One single key 21 is sufficient to lock/unlock lid 14 and secure case 3 to holder 2.

Thus, the reference fails to teach two independent security systems.

The present invention provides an improved security level having two different locking systems:

- 1) to independently lock the case; and
- 2) to lock the case with the housing.

Failure of one of the systems does not lead to failure of the other system.

Additional comments regarding the reference (Defects of the Sakai device)

Applicant believes that the Sakai reference does not provide a high degree of security. The pawl portions 10a-c are locking somewhat flimsy. Applicant believes that a simple pocket knife

or small screwdriver should be sufficient to move the pawl portion out of the engagement groove 11. Furthermore, Applicant see the possibility that the pawl portion will be deformed when the case 3 is move upwards by use of force.

Applicant also believes that the manufacturing cost of the Sakai device is higher than that of the present invention. The Sakai device requires that case 3 snugly fit into holder 2. Only small tolerances are allowed with respect to the interaction between grooves 11 and ridges 17 on the one hand, otherwise case 3 can easily be removed by slight deformation of side plate 7. The small tolerance also requires carefully handling when inserting/removing case 3 into/from holder 2 and during transportation of the case. Small deformations of grooves 11 and/or ridges 17 will lead to failure of the system.

The bolts of the present invention can be easily and cost effectively manufactured. They can be made out of sturdy materials, like hardened steel, providing a high degree of security. Also the requirements with respect to tolerances are lower since they only have to be engaged with the boreholes. Tolerance between the bolts and boreholes do not influence the degree of security when being engaged.

McConnell et al. reference

Applicant notes that the Examiner cited this reference to show a case having a handle. (Claim 19).

According to the Examiner, it would be obvious to a person skilled in the art to include a handle in the Sakai reference in order for easy transport of the Sakai case.

First, applicant notes that the reference is directed to an air sampling device which includes a **briefcase** having a handle.

Applicant notes that compared with Claim 19, the reference fails to teach: 1) a housing having boreholes to enclose a closable case; 2) a locking system to lock the case within the housing; and 3) a closable case including **locking bolts** to engage with the bolts of the housing to lock the closed case inside the housing.

Combining the references

In view of the above finding, Applicant notes that neither of the references taken alone or in combination, will teach the present invention because both references fail to teach:

1) a housing having boreholes to enclose a closable case; 2) a locking system to lock the case within the housing; 3) a closable case including **locking bolts** to engage with the bolts of the housing to lock the closed case inside the housing; and 4) **two independent security systems**.

Applicant notes that in the Sakai reference can be found the teaching that security cases can be readily accommodated in handbags (column 1, lines 14-15). This teaching leads to the

conclusion that there is no need for the case to have a handle. There is no a technological motivation to modify the Sakai's device by adding a handle.

Furthermore, Applicant notes that handles have been in the market for years; thus, if it was so obvious to a person skilled in the art to include a handle in the Sakai invention, Applicant does not understand why Sakai did not include a handle or even suggest the possibility of having a handle on his case.

In addition, Applicant notes that the Examiner has provided no motivation to combine the references beyond a general assertion of obviousness. We need to remind the Examiner that the mere fact that references can be combined does not render the resultant combination obvious. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

To prevent the hindsight combination of prior art, using the claim as a **roadmap of what to combine**, there must be some teaching or other motivation in the prior art that would direct someone to combine the references to get the claimed invention if he or she were aware of them.

Regarding Claim 20, Applicant notes that the Examiner is of the wrong opinion that the cover 14 of the Sakai reference is equivalent to the soft concealment covering of Claim 20. Furthermore, Applicant notes that the reference specifically indicated that it is unnecessary to conceal the place where the

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case is kept. (Column 2, lines 5-10, and column 4, lines 40-45).

Regarding Claim 21, the Examiner indicated that the McConnell reference teaches a cover made of leather. According to the Examiner, it would have been obvious to a person skilled in the art to modify the Sakai reference by including a leather cover.

Applicant would like to remind the Examiner that the Sakai reference specifically indicated that it is **unnecessary to conceal the place where the case is kept.** (Column 2, lines 5-10 and column 4, lines 40-45). Thus, there is not a technological motivation to add a concealment cover to the case of the Sakai reference.

Paragraphs 9-12 (Obviousness)

The Examiner rejects Claims 22 and 23 under 35 U.S.C 103(a) as being obvious over Sakai (U.S. Patent 5,170,907) in view of Specht (U.S. Patent 5,870,910) and GB 2039599 (GB '599).

The position of the Examiner can be found on pages 5-6 of the Office Action.

Applicant respectfully traverses for the same reasons as set forth above and the following remarks.

Regarding the Sakai reference

Applicant's arguments regarding the Sakai reference can be found in the previous paragraph.

Regarding the Specht reference

Applicant notes that the Examiner cited this reference to show a case with a handle.

Applicant notes that in the Sakai reference can be found the teaching that security cases can be readily accommodated in handbags (column 1, lines 14-15). This teaching leads to the conclusion that there is no need for the case to have a handle. There is not a technological motivation to modify the Sakai's device by adding a handle.

Furthermore, Applicant notes that compared with Claim 22, the reference fails to teach: 1) a case having a handle, 2) a first security locking system to independently lock the case, 3) a second locking system to lock the case with the housing; 4) a housing **including boreholes**; 5) a case having a handle; and 6) a case including locking bolts **to engage with the boreholes of the housing** to lock the closed case inside the housing.

Regarding the GB '599 reference

Applicant notes that the Examiner cited this reference to show a housing including boreholes that engage the locking bolts of the case.

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Applicant notes that this reference will not be considered by a person skilled in the art when looking for an improvement of a safe case system. This drawer has nothing to do with a case safe system according to the present invention. Furthermore, the reference fails to teach a first locking system to independently lock the case.

Neither of the references taken alone or in combination show a first and second locking system being independent from each other.

In addition, all the references fail to teach:

1) a housing having boreholes to enclose a closable case; 2) a locking system to lock the case within the housing; 3) a closable case including **locking bolts** to engage with the bolts of the housing to lock the closed case inside the housing.

Please note that according to US Patent Law, the mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination or it is a logical reason of record which justifies the combination.

Applicant notes that it is unclear how to modify the pawl member 10 of the reference, especially the pawl portions 10a-c, so that they will interact with locking bolts. One could think of replacing one of the pawl portions by a bolt to improve the sturdiness. However, this will lead to a rotational engagement

of the bolt with a corresponding engagement groove 11.

The bolts of the present invention are move in an axial direction into corresponding boreholes providing an improved security level.

Applicant notes that if the invention of the Sakai reference is modified to include a housing having boreholes that engage the locking bolts of the case, the Sakai invention would require a substantial reconstruction and redesign of the elements shown in the prior art reference, as well as a change in the basic principles under which the reference's construction was designed to operate.

Applicant notes that in column 5, lines 60 to 68, of the Sakai reference, there is an indication that the case is free of projecting surfaces.

Modifying the Sakai reference by adding the locking bolts to the case of the GB '599 references teaches away from the teaching of the Sakai reference, which requires the case to be free of projecting surfaces.

If a proposal for modifying the prior art in an effort to attain the claimed invention causes the art to become inoperable or destroys its intended function, then the requisite motivation to make the modification would not have existed. *See In re Fritch*, 972 F.2d at 1265 n.12, 23 U.S.P.Q.2d at 1783 n.12 ("A proposed modification [is] inappropriate for an obviousness

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inquiry when the modification render[s] the prior art reference inoperable for its intended purpose."); *In re Ratti*, 270 F.2d 810, 813, 123 U.S.P.Q. 349, 352 (C.C.P.A. 1959)

A §103 rejection based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, is not proper, and obviousness cannot be properly made. In short, there would be no technological motivation for engaging in the modification or change. To the contrary, there would be a disincentive. *In re Gordon* 221 USPQ 1125 (Fed. Cir 1984).

Accordingly, withdrawal of the rejection is respectfully requested.

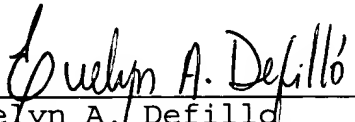
Paragraph 17 (Allowable Subject Matter)

The Examiner indicates that Claims 13 and 14 are allowed.

Applicant would like to thank the Examiner for the indication.

Favorable consideration and early issuance of the Notice of Allowance are respectfully requested.

Respectfully submitted,



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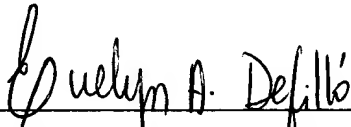
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CERTIFICATE OF MAILING AND AUTHORIZATION TO CHARGE

I hereby certify that the foregoing AMENDMENT D for U.S. Application No. 09/830,732 filed August 17, 2001, was deposited in first class U.S. mail, with sufficient postage, addressed to: Attn: Commissioner of Patents and Trademarks, P.O. Box 1450, Alexandria VA 22313-1450, on **February 24, 2005**.

The Commissioner is hereby authorized to charge any additional fees, which may be required at any time during the prosecution of this application without specific authorization, or credit any overpayment, to Deposit Account No. 16-0877.



Evelyn A. DeFillio